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10/086,146

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Robert F. Bigelow JR.

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/086,146

Applicant(s)

BIGELOW ET AL.

Examiner

Robert Mosser

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-25-06, 3-20-2006</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**



**In response to the amendment filed March 20<sup>th</sup> 2006.**

**Claims 1-62 are pending.**

**This action is Non-Final.**

**The examiner's statements of official notice in the non-final action dated January 15<sup>th</sup>, 2004 were not challenged in the proceeding reply and are now held as Applicant admitted prior art accordingly.**



***Information Disclosure Statement***

The information disclosure statements submitted 3/20/06 and 4/25/06, have been considered. Copies of the respective disclosure statements indicating their consideration are attached for the Applicant's records.

**Affidavit under CFR 1.131**

The Affidavit filed on July 17<sup>th</sup>, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Locke et al (USP 6,561,904) reference.

The Locke et al reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of

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invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Additionally the Applicant's remarks of on June 3<sup>rd</sup>, 2005 propose that the presented claims and those of the prior art could not claim the same invention as the claimed invention of Locke et al "require the group of possible payout multiplier varying with the respective outcomes", while asserting that the Applicant's instant claims "do not require this". However this issue falls on at least two issues. On a first point, the Applicant's claims do not preclude the inclusion of the above mentioned feature of Locke et al. On a second point the present claim language of claim 1, teaches selecting a multiplier from a plurality of multipliers (a group X), and on a subsequent selection selecting a "different" multiplier from the original selection thereby selecting from (a group Y wherein  $Y < X$ ). Hence through the Applicants presented claim language the Applicant indeed varies the size of a group of payout modifiers with the respective outcomes.

With regards to the amendments submitted March 20<sup>th</sup>, 2006, apparatus claims may not demonstrate a delineation based on the incorporation of functional limitations (See the 102/103 rejection of claims 1, 61, and 62 presented below for supporting rational)

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date

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of the Locke et al (USP 6,561,904) reference. The provided statement and screen shots fail to demonstrate the presently claimed functionality. The submitted exhibits demonstrate static images of a game without providing a definitive link between the images, files, any functionality that might have been associated with those images at the time of image generation and the claims as present in the instant application. There is no presented evidence addressing the content of the provided files and screen shots that might be considered objective evidence, a clear correlation between the claimed invention and that which was in the possession of the Applicants during the proposed time period, nor a demonstration of due diligence on the part of the Applicant.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained. (MPEP 712 & 37 CFR 1.131)

For these reasons the Affidavit filed on July 17<sup>th</sup>, 2004 under 37 CFR 1.131 has been reconsidered but is ineffective to overcome the Locke et al (USP 6,561,904) reference.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 6, and 61-62 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Locke** et al (6,561,904).

Locke teaches a gaming device that comprises a plurality of reels (Fig 4); a plurality of symbols on the reels (Fig 4 & Col 4:1-5:59); a triggering event associated with at least one of the symbols or a combination of the symbols occurring on the reels (Abstract); a plurality of free spins of the reels (Abstract); a plurality of multipliers associated with the free spins of the reels (Abstract & Col 4:1-5:59); and a processor which controls the reels whereupon an occurrence of the triggering event on the reels, the processor provides the free spins of the reels to a player and determines an award, if any, to provide to the player for each free spin based upon the symbols occurring on the reels from the free spin and the multiplier associated with the free spin, wherein the multiplier changes at least once during the free spins (Abstract, Col. 1: 49-62; Col. 2:55-67; Col 4:1-5:59).

As previously amended Locke further teaches the selection of a multiplier from a plurality of multipliers wherein the at least a first one of the plurality of the multipliers and a second different one of the multipliers are picked during said plurality of free reel spins, and wherein the second multiplier is picked based on the first multiplier being previously picked (Col 4:1-5:59). Specifically Locke et al teaches the selection of a first multiplier (Col 4:14-17) from a plurality of multipliers (Col 4:5-14) and altering further multiplier selection based on the previous multiplier selection according to an altered table probability demonstrated in column 4, lines 27-35 and column 5, lines 17-25, wherein the probability for the selection of a 1x multiplier is originally 4/11 and finally decreases to 0.

As presently amended claims **1**, **61**, and **62**, now include language directed to the value of a second different multiplier being predetermined based on the selection of a first multiplier. The presented amendment attempts to create a delineation between the claimed invention and the prior art of Locke based functional limitation directed to the manner in which the apparatus is employed to derive subsequent multipliers. It is noted that pages 7 through 8 of the Applicant's specification teaches this particular manner of determination as being a non-critical element of the claimed invention, capable of being incorporated in various alternative manners including the manner as taught by Locke (Applicant's specification page 9 considered in light of the Applicant's statements concerning the teachings of Locke on page 22 of the Applicant's Remarks presented March 20<sup>th</sup>, 2006).

MPEP § 2114 sets forth the following with respect to apparatus claims:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997)

And,

"[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)

Accordingly the presently claimed invention is maintained as rejected under USC 102 under Locke for incorporating functional limitations with in apparatus claims that do not distinguish the claimed invention from the invention of Locke in accordance with MPEP § 2114 as set forth above.

Alternatively if one were to consider the newly amended limitations of claims 1, 61, and 62 as bearing substitutive weight these claims would be rejected under 35 USC § 103 as unpatentable over **Locke** et al (6,561,904).

Locke teaches the claim features as correlated above with respect to claims 1, 3-4, 6, and 61-62, including the altering of a multiplier between spins and that various manners of altering the multiplier may be employed (Col 5:67-610) however, is arguably silent regarding the inclusion of increasing a multiplier value at least once by a predetermined amount during the free spins of the bonus reels based on a value of the previous multiplier or similarly the value of a second different multiplier is predetermined based on a value of a first multiplier that was previously selected. At the time the invention was made, it would have been an obvious matter of design choice to a person



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of ordinary skill in the art to increase a multiplier value at least once by a predetermined amount during the free spins of the bonus reels in the game of Locke because, one of ordinary skill in the art at the time of invention would have recognized the two processes of incrementing the multiplier as equivalents. This equivalency is further understood to be shared by the Applicant's specification wherein the Applicant has provided multiple manners of increasing the multiplier without designating any particular advantage, purpose, or stated problem solved through the particular utilization of predetermined multiplier increment juxtaposed non-predetermined multiplier increment (Applicant's specification Pages 17, 21-23). One of ordinary skill in the art, furthermore, would have expected Locke's alteration of the multiplier value (Locke Claims 9,12, Col 4:36-5:25 & Col 6:5-13 Wherein Locke teaches successively selecting new multiplier values for each spin), and the Applicant's claimed predetermined alteration of the multiplier value by a predetermined amount to perform equally well as both methods would serve to alter the value of the multiplier across multiple game spins and hence equally serve the Applicant's described purpose for the inclusion of this feature.

Therefore it would have been prima facie obvious to modify Nash to obtain the invention as specified in claims **1**, **61**, and **62** because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Nash.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **2**, and **5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Locke et al** (6,561,904).

Regarding claim **2**, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the number of the free spins being predetermined. The inclusion of features that are preset/predetermined in slot machines is noted as being Applicant admitted prior art. This feature makes it easier to predict outcomes and payouts for the gaming establishment resulting in the gaming establishment not losing excessive amounts of money. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Locke to include predetermining the

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number of free spins in order to allow the establishment to predict outcomes and payouts in an easier manner.

Regarding claim **5**, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the feature of the number of free spins being determined by the player choosing masked selections. Allowing the players to choose masked selections in a slot gaming device is noted as being Applicant admitted prior art and increases the element of surprise; thereby increasing player participation and anticipation. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include allowing the players to choose masked selections in the slot gaming device of Locke with the free spin feature on order to increase player participation and anticipation.

Claims **7-60**, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Locke et al* (6,561,904) in view of *Wilson, Jr. et al* (US 6,004,207).

Regarding claims **7-17**, and **31-60**, Locke teaches all the limitations of the claims as discussed above, however is silent regarding the inclusion of an incrementor symbol. In a related *Wilson, Jr. et al* teaches a slot machine with incremental pay-off multiplier (*Wilson Abstract*) that increases a multiplier by a fixed or random amount through the play of the game and responsive to the occurrence of a designated symbol on the reels (*Wilson Abstract*, Col 4:39-5:5, & Claims 11, 14) to provide a significant incentive for a player to continue to play a game (*Wilson Col 1:35-51*). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the multiplier

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symbol of Wilson as one of the symbols of Locke in order to provide increased excitement and anticipation of the game as taught by Wilson.

Further as Locke is noted to shift the probability of selecting higher multipliers with each successive free reel spin the presented modification would merely entail altering the provided probability table of Locke to account for the possible occurrence of the incrementor symbol or alternatively introducing the appearance of an incrementor symbol as a means for ensuring a player perceives the alteration of probability.

Regarding claims **18-30**, Locke teaches all the limitations of the claims as discussed above. Locke is silent on the feature of a consolation prize. However, the awarding consolation prizes in the gaming art is noted as being Applicant admitted prior art. Awarding consolation prizes provides the players with a cheerful feeling in the event of monetary losses; thereby, making the player want to play the game again and risk wagering. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate this feature of consolation a prize into Locke in order encourage continuing play of a gaming device by a user.

### ***Response to Arguments***

Applicant's arguments filed March 20<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

On page 19 of the remarks by Applicant dated March 20<sup>th</sup>, 2006, the Applicant states the following, "The office Action stated that the Affidavit of Anthony J. Baerlocher, which was submitted by Applicants in the Response to Office Action mailed on July 13, 2004, is not effective to overcome Locke. The Office Action takes the position that the present application is claiming the same subject matter as Locke." In the interest of clarity, the previous Office Action presented in similar light as the instant Office Action continues to present, multiple grounds for which the Affidavit is deemed as not effective beyond the instant application claiming the same subject matter as Locke. The Applicant's statements maybe construed to indicate a singular basis for the Affidavit being deemed not effective, however as noted in the previous office action dated November 2<sup>nd</sup>, 2005, the interview of January 31<sup>st</sup>, 2006, and further clarified above in the instant Office Action there are multiple grounds beyond this singular basis for the Affidavit submitted July 17<sup>th</sup>, 2004 being found as not effective. While the Examiner fully understands that there may be other motivating factors for the Applicant's specific redress of any possible correlations between their presented claims and those of Locke the preceding is provided merely to clarify the reasons for which the Affidavit was deemed not effective.

On page 22 of the Applicant's remarks, the Applicant proposes the following interpretation of Locke "Selected multipliers are removed from the group for subsequent free spins". However upon the review of Locke the removal of multiplier options is based upon a prior selection of any multiplier and in other words the selection that is removed need not be the multiplier selected (Locke Col 4:49-51, 4:58-61). Additionally the Applicant proposes, "The random selection of the multiplier for each free spin is independent of the selection of the multiplier for each previous free spin." The term "independent" could

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be interpreted by some to suggest that there is absolutely no relationship between the Locke's selection of a multiplier and a subsequent selection of a multiplier however, as each selection effects the odds of a subsequent selection, there must be at the very least some degree relation between the selections. The Examiner does partially, agree with the Applicant however, in that the selection for each free spin of Locke is not specifically taught as being based on the specific values of the multipliers selected in a previous spin. Accordingly Locke is not relied upon solely for the redress of this feature as presented in the rejections of at least claims **1**, **61**, and **62** as presented above.

On page 24 of the Applicant's remarks, the Applicant states "Furthermore, in Locke, the value of the multiplier does not change at least once by a predetermined amount during the free spins of the bonus reels based on a value of the previous multiplier." The exemplary embodiment of Locke as presented in columns four through five teaches a multipliers which range in value between one and five wherein the game selects a first multiplier alters the probability of selection of the multiplier then selects a new multiplier in combination with remaining game features. This selection process repeats five times prior to termination. Hence after any first multiplier is selected the subsequent selected multiplier must be within a preset range (ie If 5 was initially selected as the multiplier the absolute largest numeric distance would be acquired through the subsequent selection of a 1 with a distance of 4 units (1,2,3,4) or alternatively 2 selections (1,3)). Hence as claimed a "predetermined amount" as it correlates to the invention of Locke is understood to encompass the predetermined ranges such as those demonstrated in the proceeding sentence.

Applicants additionally note a discrepancy between the Examiner's previous rejection of claims 39, 40, and 44. The Examiner apologizes for any confusion resultant thereof and has accordingly made this action non-final so as to ensure that the Applicant has the proper opportunity to respond to the pending rejections.

Applicants state that Locke does not determine the value of the multiplier based on the symbols appearing on the wheels as presently claimed this feature is provided for in the rejection above through the combination of a Locke and Wilson.

On page 25 of the Applicant's remarks, the Applicant challenges the combination of Locke and Wilson under the interpretation that the combination "...is a product of impermissible hindsight since the incrementing multiplier of Wilson, Jr. teaches away from and destroys the random and independent selection of multipliers taught by Locke". It is noted that the invention of Wilson and Locke both teach the use of multipliers in a reel based game, that they both include a random determination of the multiplier value, that over multiple plays the value of the multiplier would increase in both inventions and finally that "independent" selection of multipliers taught by Locke must be related to the meaning of this particular terminology as discussed in the response directed to page 22 above. The selection of multiplier value is based on a random determination in both of the prior art references where Locke bases the random selection off of varying probabilities in multiple game rounds (Locke Col 4:49-5:59), while Wilson alternatively maintains the probabilities and utilizes a cumulative value of the random number determinations to determine the multiplier value. The resulting combination teaches the

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random selection of a multiplier based on cumulative selections and hence may not be construed as destructive as so suggested.

In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

On pages 26-27 of the Applicant's remarks, the Applicant challenges the combination of Locke and Wilson for failing to teach the determination if an incrementor symbol has appeared on the reels, increasing the multiplier on the occurrence of a incrementor symbol and modifying any resultant award utilizing the multiplier. The Applicant bases this challenge generally on an interpretation of solely power point system of Locke as not allowing the increase in the multiplier for each round. However as now noted in the rejection of the relevant claims above, Wilson teaches this portion of the invention absent any mention of a power point system in at least the steps patented claim 14.

Remaining Applicant arguments are premised on the preceding Arguments addressed above and fall for their reliance thereon.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MARK SAGER  
PRIMARY EXAMINER

REM